REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed August 24, 2004. In the Office Action, the Examiner noted that claims 1-8 are pending in the application, and that claims 1-8 stand rejected. The Examiner also noted that the Abstract is objected to because it consists of more than one paragraph, exceeds 150 words, and contains the phrase "is described" in line 11.

By this response, the Applicants have amended the Abstract to contain fewer than 150 words and to delete the objected to phrase. Applicants have also amended claims 1, 3, 5, and 7-8 and have cancelled claims 4 and 6.

In view of the above amendments and the following discussion, the Applicants submit that the claims pending in the application are believed to be not anticipated and non-obvious under the respective provisions of 35 U.S.C. §§102 and 103. Thus, the Applicants believe that the application is in condition for allowance.

REJECTIONS

35 U.S.C. §102

Claim 4

The Examiner rejected claim 4 under 35 U.S.C. §102(b) as being anticipated by Young et al. (U.S. Patent 5,353,121, hereinafter "Young"). In response, the Applicants have cancelled claim 4, thereby rendering the rejection moot.

Claim 5

The Examiner rejected claim 5 under 35 U.S.C. §102(e) as being anticipated by Saib et al. (U.S. Patent 5,973,682, hereinafter "Saib"). Applicants respectfully traverse the rejection.

Independent claim 5 recites:

> "A method for navigating between TV channels, the method comprising:
> transmitting broadcast video displays on multiple TV channels from a server to a terminal;
> transmitting a channel information window having information about multiple channels from the server to the terminal;

overlaying the channel information window on a broadcast video display on a display;

navigating among channels within the channel information window by selecting information about another channel; and

changing the broadcast video display in synchronization with the navigating among channels."

The Saib reference (which is discussed in more detail subsequently) fails to disclose each and every element of the claimed invention, as arranged in claim 1. Specifically, the Saib reference fails to teach transmitting a channel information window having information about multiple channels from the server to the terminal. As described in Saib at column 4, lines 31-55, the program list is generated in a CPU in the user terminal, using user settings that are stored in non-volatile memory.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). The Saib reference fails to disclose each and every element of the claimed invention, as arranged in the claim.

As such, the Applicants submit that independent claim 5 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore, the arguments presented below with regard to the 35 U.S.C. §103(a) rejection of claim 1 based on Saib and Hooper generally apply to claim 5. Therefore, the Applicants respectfully request that the 35 U.S.C. §102 rejection be withdrawn and that the Examiner consider the arguments presented below with regard to the 35 U.S.C. §103(a) when re-examining claim 5.

35 U.S.C. §103

Claims 1 and 3

The Examiner rejected claims 1 and 3 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner rejected claims 1 and 3

as being unpatentable over Saib in view of Hooper et al. (U.S. P patent 5,422,674, hereinafter "Hooper"). Applicants respectfully traverse the rejection.

Applicants' independent claim 1 recites:

> "A method for providing a channel information window overlaying a broadcast video, the method comprising:
> transmitting a broadcast video presentation from a server to a terminal;
> transmitting a bitmap for a channel information window from the server system to the terminal;
> receiving at the terminal a signal to activate the channel information window; and
> overlaying the bitmap for the channel information window over the broadcast video on a display associated with the terminal."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Saib reference and the Hooper reference alone and in combination fail to teach or suggest the Applicants' invention as a whole.

The Saib reference discloses a graphical user interface in the form of an interactive electronic program guide. That electronic program guide is locally generated at a user terminal by a CPU that has access to stored user information.

The Saib reference fails to teach or suggest transmitting a bitmap for a channel information window from a server to a terminal. Recognizing this, the Examiner relies on Hooper as teaching a user interface bitmap that is generated at a server and which is sent to user terminals.

However, the Hooper reference fails to bridge the substantial gap as between the Saib reference and the Applicants' invention. The Hooper reference discloses a graphical user interface formed using Motion Picture Expert Group (MPEG) video compression at a server (authoring station) and that is then sent to user terminals. As taught in the Hooper reference, the graphical user interface is formed by creating a still

image comprised of a background image and added foreground elements, such as buttons, which is subsequently encoded and sent to a user, reference Hooper starting at column 2, line 59.

The Hooper reference fails to teach or suggest Applicants' invention recited in claim 1. Specifically, Hooper does not disclose transmitting both a broadcast video presentation and a channel information window bitmap from a server to a terminal. Additionally, Hooper does not disclose selectively overlaying the channel information window bitmap on the broadcast video. Therefore, the Hooper reference fails to teach or suggest the Applicants' invention as a whole.

Overlaying a channel information window bitmap on a broadcast video signal when both the channel information window bitmap and the broadcast video signal are sent by a server is far different than generating a local channel information window bitmap and then overlaying that local channel information window bitmap on a broadcast video signal. The hardware requirements, technical complexity, costs, and performance requirements are different in the two cases. While Hooper teaches creating and sending a server generated guide, Hooper does not suggest that the guide can be or should be overlaid on a broadcast video signal. Accordingly, the Saib reference and the Hooper reference, alone or in combination, fail to teach or suggest Applicants' invention as a whole.

Furthermore, claim 3 depends directly from independent claim 1 and recites additional features thereof. As such and for at least the same reasons as discussed above, the Applicants submit that claim 3 is not obvious and fully satisfies the requirements of 35 U.S.C. §103. Additionally, claim 5 (discussed above) recites features similar to those discussed above with reference to claim 1. Therefore, the Applicants respectfully submit that the Examiner's rejection of claims 1 and 3 should be withdrawn, and that claim 5 is also allowable over Saib and Hooper.

Claim 2

The Examiner rejected claim 2 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner rejected claim 2 as being

unpatentable over Saib and Hooper as applied to claim 1 and further in view of Banker et al. (U.S. Patent 5,247,364, hereinafter "Banker"). The Applicants respectfully traverse the rejection.

For at least the reasons discussed above with respect to claim 1, the Applicants submit that claim 2, which depends directly from independent claim 1 and recites additional features thereof, is patentable and non-obvious over Saib and Hooper under the provisions of 35 U.S.C. §103(a). Furthermore, the Banker reference fails to bridge the substantial gap as between the Saib and Hooper references and the Applicants' invention.

The Banker reference discloses an in-band subscription television system in which a subscriber terminal is adapted to receive a television signal having video, audio, and data information. While the Banker reference may relate to a very useful invention, that invention fails to disclose or even suggest overlaying a channel information window bitmap on a broadcast video signal when both the channel information window bitmap and the broadcast video signal are sent by a server to a user.

Accordingly, the Saib, Hooper and Banker references, alone or in combination, fail to teach or suggest Applicants' invention as recited In claim 1 as a whole.

As such and for at least the same reasons as discussed above, the Applicants submit that claim 1 remains allowable over the combination of Saib, Hooper and Banker. Thus claim 2 is allowable at least for its dependency from claim 1. Therefore, Applicants respectfully submit that the Examiner's rejection of claim 2 should be withdrawn.

Claims 6 and 7

The Examiner rejected claims 6 and 7 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner rejected claims 6 and 7 as being unpatentable over Saib in view of Hooper. Applicants respectfully traverse the rejection of claim 7. Claim 6 has been cancelled in view of amendments to claim 5.

For at least the reasons discussed above with respect to the Examiner's 35 U.S.C. §102 rejection of claim 5 and with respect to the 35 U.S.C. §103(a) rejection of

claim 1 (claim 5 recites limitations similar to some found in claim 1), the Applicants submit that the Saib reference and the Hooper reference, when taken individually or in any permissible combination, fail to teach or suggest Applicants invention as a whole. For at least the same reasons, the Applicants submit that claim 7, which depends directly or indirectly from independent claim 5 and recite additional features thereof, is also patentable. Therefore, Applicants respectfully submit that the Examiner's rejection of claim 7 should be withdrawn.

Claim 8

The Examiner rejected claim 8 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner rejected claim 8 as being unpatentable over Saib in view of Billock (U.S. Patent 5,619,249, hereinafter "Billock"). Applicants respectfully traverse the rejection.

For at least the reasons discussed above, Applicants submit that the Saib reference fails to teach or suggest Applicants invention as recited in the specification and claimed in claim 5 as a whole. For at least the same reasons, Applicants submit that claim 8, which depends directly from independent claim 5 and recites additional features thereof, is also patentable and non-obvious over the Saib reference under the provisions of 35 U.S.C. §103(a).

Furthermore, the Billock reference fails to bridge the substantial gap as between the Saib reference and the Applicants' invention. In particular, the Billock reference discloses a video on demand telecasting service that includes an interactive interface for facilitating viewer selection of video programs. The interactive interface allows a viewer to scan through a list of video programs available on the demand telecasting service. The interactive interface provides the viewer with still images, full-motion previews, and textual descriptions of the available programs.

However, the Billock reference fails to teach or suggest transmitting both a broadcast video presentation and a channel information window bitmap from a server to a terminal, and then overlaying the channel information window bitmap on the broadcast video. Therefore, the Billock reference fails to close the substantial gap between Saib

and applications invention recited in claim 5. Since claim 8 depends from claim 5, claim 8 is also allowable. Accordingly, the Saib and Billock references, alone or in combination, fail to teach or suggest Applicants' invention as a whole.

As such and for at least the same reasons as discussed above with respect to claim 5, the Applicants submit that claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103. Therefore, Applicants respectfully submit that the Examiner's rejection of claim 8 should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims presently in this application are neither anticipated nor obvious under the respective provisions of 35 U.S.C. §§102 or 103. Applicants believe that this application is in condition for allowance. Reconsideration of this application and its swift passage to issue are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or John M. Kelly at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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